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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,087	01/29/2004	Harald Michi	10191/3439	4599
26646	7590	09/22/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			MANCHO, RONNIE M	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/767,087

Applicant(s)

MICHIE ET AL.

Examiner

Ronnie Mancho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-9 and 11-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3,6-9 and 11-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Status

1. This is a final action in response to the application submitted 4/14/06.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In amended claim 1, the applicant recites “ **which operating modes can be activated in different speed ranges, each operating mode having a corresponding number of speed regulating functions**, wherein a change in a current operating mode which results in the **loss of a speed regulating function occurs solely via a command of the driver to the input device**”.

This is new matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
5. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1-14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrases “which operating modes **can be** activated”; “the second operating mode being **activatable**” do not indicate if the limitations are part of the invention or not.

The applicant further claims “a speed range”. A speed range was not defined or provided.

The applicant further claims “a loss of a speed regulating-function”. The limitation is indefinite. It is not clear if the applicant is referring to speed deactivation function rather than the claimed “a loss of a speed-regulating function”.

The applicant further claims “a higher vehicle speed range”, “lower vehicle speed range”. These limitations are indefinite.

It is further not clear how “wherein **an upper limit of the lower speed range..... provides in certain instances an automatic braking of the vehicle to a standstill**”. The applicant has not explained this limitation.

The resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

In claim 4, the applicant recites “a second of the plurality of operating modes is for lower vehicle speeds, the second operating mode being activatable in a speed range having an upper limit at least equal to the limiting speed”. This limitation is confusing because the second speed is lower than the claimed “limiting speed” and it is in “a speed range having an upper limit *at least* equal to the limiting speed”. It is not clear if the applicant intends to claim --at most--

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instead of “at least”. The claimed “at least” would mean that the second operating speed must be above the “limiting speed”, and this will contradict the first operating mode.

Claims 2-14 are rejected for depending on a rejected base claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hirasago (6658344).

Regarding claim 1, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses a speed controller for a motor vehicle comprising:

an input device to receive input of a desired speed by a driver (see inputs as in figs. 1-31), the input device having a plurality of operating modes (figs. 6 A-C; fig. 31 ) differing in

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functional scope, which operating modes can be activated in different speed ranges, each operating mode having a corresponding number of speed regulating functions, wherein a change in a current operating mode which results in the loss of a speed regulating function occurs solely via a command of the driver (cols. 2&3) to the input device; and

a decision unit to determine, using predefined criteria, whether a change in the desired speed input by the driver is to be interpreted as a command for changing the current operating mode (controller; cols. 2, 4-7);

wherein a first of the plurality of operating modes is an operating mode for a higher vehicle speed range that is activatable only above a limiting speed, and a second of the plurality of operating modes is for a lower vehicle speed range, and wherein an upper limit of the lower speed range is at least equal to the limiting speed and provides in certain instances an automatic braking of the vehicle to a standstill;

wherein the decision unit automatically causes a change from the first operating mode into the second operating mode when the speed of the vehicle decreases to below the limiting speed and then automatically limits the desired speed to a value permitted in the second operating mode;

wherein the decision unit deactivates the speed controller when, in the second operating mode, the speed of the vehicle increases, and the driver does not input a new desired speed, while the actual speed of the vehicle lies within a predefined speed range.

Regarding claim 2, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, further comprising a display device adapted to display the current operating mode.

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Regarding claim 3, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, further comprising a signal device to signal to the driver a change in the current operating mode.

Regarding claim 6, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit automatically causes a change from the first operating mode into the second operating mode when the desired speed is lower than the limiting speed  $V_s$  and when the actual speed of the vehicle is less than  $V_s+h_1$ , where  $h_1$  has a non-negative value.

Regarding claim 7, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit automatically causes the change from the first operating mode into the second operating mode when one of the following occur:

- a) the desired speed is increased to a threshold value which is at least equal to the limiting speed; and
- b) the actual speed of the vehicle does not increase to the limiting speed within a predefined time interval.

Regarding claim 8, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit automatically causes the change from the second operating mode into the first operating mode when the desired speed is increased by the driver to a value that is greater than  $V_s+h_1$ ,  $V_s$  being the limiting speed and  $h_1$  having a non-negative value.

Regarding claim 9, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit deactivates the speed controller when, in the

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second operating mode, the desired speed is less than or equal to the limiting speed  $V_s$  and the actual speed is greater than a threshold value  $V_s + h_2$ , where  $h_2$  has a non-negative value.

Regarding claim 11, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit activates the speed controller in the first operating mode when, upon the input of the desired speed, the actual speed of the vehicle is greater than the limiting speed and the decision unit activates the speed controller in the second operating mode and limits the desired speed when, upon the input of the desired speed, the actual speed of the vehicle is less than or equal to the limiting speed.

Regarding claim 12, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 11, wherein the decision unit activates the speed controller in the second operating mode only when a target object is located by a distance sensor system and the distance from the vehicle to this target object lies within a predefined range.

Regarding claim 13, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 12, wherein the decision unit automatically deactivates the speed controller in the second operating mode when the target object is not detected lost and is not re-detected within a predefined time span.

Regarding claim 14, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 12, wherein the decision unit automatically deactivates the speed controller in the second operating mode when the distance between the vehicle and the target object becomes greater than a predefined value.



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**MPEP 2114.**

9. The statement of intended use or field of use, "activatable", "can be activated", "adapted to", etc clauses are essentially method limitation or statement of intended or desired use.

In actuality, the following limitations are essentially method limitation or statement of intended or desired use: "operating modes can be activated in different speed ranges, each operating mode having a corresponding number of speed regulating functions, wherein a change in a current operating mode which results in the loss of a speed regulating function occurs solely via a command of the driver to the input device";

"determine, using predefined criteria, whether a change in the desired speed input by the driver is to be interpreted as a command for changing the current operating mode";

"wherein a first of the plurality of operating modes is an operating mode for a higher vehicle speed range that is activatable only above a limiting speed, and a second of the plurality of operating modes is for a lower vehicle speed range, and wherein an upper limit of the lower speed range is at least equal to the limiting speed and provides in certain instances an automatic braking of the vehicle to a standstill";

"wherein the decision unit automatically causes a change from the first operating mode into the second operating mode when the speed of the vehicle decreases to below the limiting speed and then automatically limits the desired speed to a value permitted in the second operating mode";

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“wherein the decision unit deactivates the speed controller when, in the second operating mode, the speed of the vehicle increases, and the driver does not input a new desired speed, while the actual speed of the vehicle lies within a predefined speed range”.

Thus, the claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647. See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

### ***Response to Arguments***

10. Applicant's arguments filed 4/14/06 have been fully considered but they are not persuasive.

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Applicants arguments are drawn entirely to method limitations. Assuming that the prior art did not disclose the method limitations, which the examiner is not conceding, the prior art anticipated the structural limitations of the claims and thus is capable of performing the method limitations.

It is believed that the prior art anticipates the claims. The rejections thus stand.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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*Communication*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571/272/6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571/272/6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronnie Mancho  
Examiner  
Art Unit 3663

September 14, 2006

  
JACK KEITH  
SUPERVISORY PATENT EXAMINER